

Dkt. 0575/64075/JPW/BJA

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9-27-02  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Norman Latov and Armin Alaedini  
U.S. Serial No. : 09/825,572 Examiner: C. Chin  
Filed : April 3, 2001 Group Art Unit: 1645  
For **RECEIVED:** A SURFACE PLASMON RESONANCE BIOSENSOR FOR  
SEP 24 2002 MEASUREMENT OF ANTI-GLYCOLIPID ANTIBODIES  
IN NEUROPATHY

TECH CENTER 1600/2900

1185 Avenue of the Americas  
New York, New York 10036  
September 16, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO AUGUST 27, 2002 OFFICE ACTION

This Communication is submitted in response to the August 27, 2002 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to this August 27, 2002 Notice is due September 27, 2002. Accordingly, this Communication is being timely filed.

Species Election

In the August 27, 2002 Office Action the Examiner stated that this application contains claims directed to the following patentably distinct species of the claimed invention:

(A) Antigen - glycolipid (claims 2, 3, 5, 8, 15, 16, 17, 19, 21, and 22)

(B) Antigen - ganglioside (claims 4, 9, 10, and 17)

The Examiner stated that the applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the

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merits to which the claims shall be restricted if no generic claim is finally held to be allowable, and that, currently, claims 1, 6, 7, 11, 12, 13, 14, 18, 20, 23, 24, 25 and 26 are generic.

The Examiner stated that applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. The Examiner also stated that an argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. The Examiner further stated that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise included in all the limitations of an allowed generic claim as provided by 37 CFR §1.141. The Examiner stated that if claims are added after the election, applicant must indicate which are readable upon the elected species.

The Examiner stated that applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. §1.143)

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Examiner's Species (B), i.e. ganglioside.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require application to be

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restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the species (A) and (B) are not independent.

Under M.P.E.P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect...". The species (A) and (B) are related in that they are drawn to similar compounds, compositions, and methods of use. All of the methods relate to detecting antibodies in a solution.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. §121.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to species (B) would necessarily identify art for the species (A). Since there is no serious burden on the Examiner to examine species (A) and (B) in the subject application, the

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Examiner must examine the entire application on the merits.

Applicants maintain that species (A) and (B) define a single inventive concept. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the species election requirement and examine claims 1-26 on the merits.

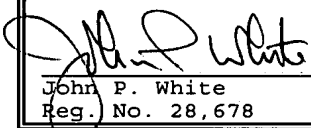
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

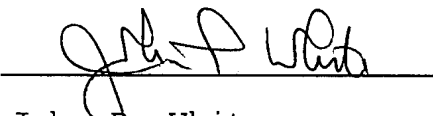
Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

  
John P. White  
Reg. No. 28,678

9/16/02

Date

  
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